

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: JERUSSI *et al.*

Application No.: 09/987,930

Filed: November 16, 2001

Art Unit: 1614

Examiner: Wang

Attorney Docket No.: 4821-438

BUPROPION METABOLITES
AND METHODS OF THEIR
SYNTHESIS AND USE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action, dated March 4, 2003, in which the application was examined for restriction purposes only. Enclosed herewith is a Petition for Extension of Time, with provision for the required fee.

Applicants respectfully request entry of the following remarks and provisional election.

REMARKS

The Examiner sought to restrict this application, under 35 U.S.C. § 121, to one of five (5) groups: Group I, directed to claims 1-5, drawn to methods of treating a disorder ameliorated by the inhibition of neuronal monoamine reuptake; Group II, directed to claims 6-12, drawn to methods of treating erectile dysfunction; Group III, directed to claims 13-19, drawn to methods of treating an affective disorder; Group IV, directed to claims 39-53, drawn to pharmaceutical compositions and dosage forms of a bupropion metabolite; and Group V, directed to claims 54-57, drawn to processes for preparing a bupropion metabolite.. Applicants provisionally elect, with traverse, Group III (i.e., claims 13-19). Applicants respectfully submit, however, that a single search would encompass the claims as currently presented. The restriction requirement should therefore be withdrawn.

To be specific, Applicant respectfully notes that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." Manual of Patent Examining Procedure § 803 (emphasis added).

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All of the pending claims are directed to methods or pharmaceutical compositions comprising a bupropion metabolite. Thus, a bupropion metabolite is present in all of the claims. Therefore, even if the Applicant were to elect one of the groups, the required search would necessarily encompass the subject matter of the other groups.

Should the Examiner disagree, Applicant reserves the right to petition from the restriction requirement under 37 C.F.R. § 1.144. Applicant further reserves their right to file one or more divisional, continuation, or continuation-in-part applications directed to the subject matter recited by the non-elected claims, as well as to any other matter disclosed in the present application, which is not encompassed by the elected claims.

Aside from the extension of time fees, no fee is believed due for this submission. However, should any additional fee be required, please charge such fee to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Date: June 4, 2003

Respectfully submitted,

 48,907

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